

REMARKS

Claims 5 to 7, 9, and 11 to 23 are pending and under examination in this application.

Claim Rejections – 35 U.S.C. § 102

The Examiner has rejected claims 5 to 7, 11 to 13, 15, 16, 18, and 20 to 22 under 35 U.S.C. § 102(b) as being anticipated by Hawkins et al. (4,790,812). Applicants respectfully traverse this rejection.

Applicants note that the present rejection substantially repeats the rejection set forth in the prior Office Action dated February 22, 2008. Applicants responded to the prior Office Action in a Response dated May 19, 2008. The remarks contained in that Response are equally applicable to the present rejection of the claims. For the sake of brevity Applicants will not repeat those remarks in their entirety in this Response but incorporate them herein by reference.

Claims 5 and 12 are the only independent claims that are pending. It is fundamental that for a reference to anticipate a claim it must either explicitly, implicitly or inherently disclose or contain all of the elements of the claim. When this standard is correctly applied Hawkins does not anticipate either claim 5 or claim 12 or any of the other pending claims, each of which depend from either claim 5 or claim 12.

Claim 5 is an independent claim directed to a method of protecting a patient from embolization during a percutaneous procedure on a vessel and includes the step of “expanding the vessel at the treatment site”. It is Applicants understanding that claim 5 has been rejected based on the Examiner’s belief that when the device disclosed in Hawkins is used it must “inherently...apply a centrifugal force to the

embolization of the vessel and therefore must cause at least some degree of radial [expansion] of the vessel”. Applicants submit that the Examiner has failed to provide a reasonable factual and/or technical basis for this conclusion. The mere fact that Hawkins discloses a tapered drill head that rotates does not support the conclusion that use of the device will apply a centrifugal force to the vessel resulting in “expanding the vessel at the treatment site”. Rather, Applicants believe that for a centrifugal force to arise from rotation of the drill head the device must be radially unbalanced or radially asymmetric. Neither condition is disclosed or taught by Hawkins. Further, Applicants would like to respectfully remind the Examiner that to establish inherency it is not sufficient that a characteristic may occur or be present in the prior art. Rather, the characteristic must necessarily be present in the prior art. (see, MPEP 2112). Even if, for the sake of argument, it might be possible to use the device disclosed in Hawkins in a manner which would result in expansion of the vessel there is no reason to believe that expansion of the vessel would necessarily result from use of that device. Therefore, Applicants submit that claim 5, and claims 6, 7, 9, 11, 15, 16, and 18 which depend from claim 5, are not anticipated by Hawkins.

Claim 12 is an independent claim directed to a percutaneous system for treating a vessel at a region of stenosis and filtering emboli. The system includes a catheter having a treatment device with a “radially expandable member”. Hawkins does not disclose a system having a catheter which has a treatment device with a radially expandable member. In rejecting the claims the Examiner states that Hawkins discloses a device that, during use, “must cause at least some degree of radial expanding of the vessel.” As discussed above, the Applicants dispute the correctness of that conclusion. However, regardless of the correctness of that conclusion, the Examiner still has not identified any element of Hawkins that comprises a treatment device with a “radially expandable member”. Clearly, tapered drill head 36 is not “radially expandable” as that term would be

understood by a person of skill in the art. It is a device of constant dimension which merely tapers inwardly in the distal direction. Further, no other component of the treatment device disclosed in Hawkins appears to be radially expandable. Therefore, Applicants submit that claim 12, and claims 13 and 20 to 22 which depend from claim 12, are not anticipated by Hawkins.

Claim Rejections – 35 U.S.C. § 103

The Examiner has rejected claims 14 and 16 to 23 under 35 U.S.C. § 103(a) as being obvious over Hawkins (4,790,812) in view of Simon (4,425,908). Applicants respectfully traverse this rejection.

As set forth above claims 5 and 12, the only independent claims, distinguish over Hawkins for the reasons stated. Simon does not correct the deficiencies of Hawkins in connection with claims 5 and 12. Claims 14 and 16 to 23 depend from either claim 5 or claim 12 and add further limitations. Therefore, claims 14 and 16 to 23 are allowable for at least the same reasons as claims 5 and 12.

Based on the foregoing Applicants respectfully request that the rejections of the pending claims be withdrawn.

Response
Applicants: Rudy Mazzocchi et al.
Serial No.: 10/607,328


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Respectfully submitted,

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By



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